REMARKS

Applicant has canceled claims 2, 5, 12, 15, 22, and 25 without prejudice or disclaimer, and amended claims 1, 3, 8, 11, 13, 18, 20, 21, 23, 28, and 31. Accordingly, claims 1, 3-4, 6-11, 13-14, 16-21, 23-24, and 26-33 are pending for examination with claims 1, 11, 21, and 31 being independent claims.

Objections to the Specification

In the interview of Sept. 22, Examiner Day objected to the specification in several places. Specifically, the cross reference to a related application needed to be updated, a typographical error in a reference numeral needed to be corrected on page 11, and a typographical error on page 21 needed to be correct. In response, Applicant submits the amendments to the specification as noted above. Thus, Applicant believes that the present application is in allowable form.

Indication of Allowability

Initially, the undersigned wishes to thank Examiner Day for the courtesies extended in the telephone interviews on September 21 and 22, 2005. In the brief discussion on September 21, regarding the rejections under § 102, Examiner Day stated that the dependent claims 5, 15, and 25 would be allowable if rewritten to incorporate the limitations of the independent claims (1, 11, and 21 respectively) and any intervening claims (2, 12, and 22 respectively). Although Applicant believes that the claims as previously pending are patentable over the cited art, Applicant has canceled claims 2, 5, 12, 15, 22, and 25 and incorporated those limitations into the appropriate independent claim to further prosecution of the pending application. Thus, Applicant

believes that independent claims 1, 11, and 21 are allowable. Claims 3-4, 6-10, and 32-33 depend from independent claim 1, claims 13-14 and 16-20 depend from independent claim 11, claims 23-24 and 26-30 depend from independent claim 21, and thus should be allowable for at least the same reasons.

Applicant has also incorporated limitations similar to claims 12 and 15 into independent claim 31. Thus, in view of the Examiner's indication of allowability of independent claim 11, Applicant believes that claim 31 is also allowable.

Potential 35 U.S.C. § 112 Rejections

In the interview of Sept. 21, Examiner Day indicated that the amended text of claim 31 may include new matter as defined by 35 U.S.C. § 112¶1. Specifically, the Examiner did not appear to see any support in the specification as filed for the term of benchmark. Applicant respectfully traversed.

In the interview of Sept 22, Applicant directed the Examiner's attention to the definition of the term benchmark in the Microsoft Computer Dictionary, 5th Ed., Microsoft Press, 2002, as "a test used to measure hardware or software performance. Benchmarks for hardware use programs that test the capabilities of the equipment—for example, the speed at which a CPU can execute instructions or handle floating-point numbers. ..." In addition, the specification as filed provides several examples of a benchmark. For example, the specification at page 28, lines 19-20 states "A benchmark measures the cost of C operations on a specific system and combines workload RUDs to determine computational costs." In another example, the specification at page 26, lines 25-27 states "The evaluation engine also creates and configures model classes based upon a specified hardware model." Such model classes are an example of a hardware performance benchmark. The specification in FIGS. 8 and 9 depicts object interaction of a hardware API that occurs during a workload definition state and when the evaluation

engine deploys underlying hardware models. Moreover, the Appendix at page 33 depicts a table indicating the data types of a hardware model API. These data types include a device type, scope of model, workload type process by model, model configuration parameters, any of which may be interpreted as at least a portion of a hardware performance benchmark. In this manner, applicant believes that the use of hardware performance benchmark is sufficiently supported in the specification as filed. Thus, the indication of a rejection under § 112 ¶1 should be withdrawn.

In the interview of Sept. 22, Examiner Day indicated that claims 8, 18, and 28 may not provide sufficient antecedent basis under 35 U.S.C. § 112 ¶2. Specifically, line 5 of the claims 8, 18, and 28 indicates component-specific traces and line 6 indicates hardware-specific traces. Also, the preamble of claims 8, 18, and 28 indicates rendering an output trace in a component specific format. To address the Examiner's concerns, Applicant has amended claims 8, 18, and 28. Accordingly, Applicant believes that the indications of unpatentability under § 112 should be withdrawn.

The Examiner also indicated that claim 12 as previously presented was rejectable under § 112 ¶1. Specifically, the component configuration had no antecedent basis. Thus, in amending claims 11 and 31 to include limitations similar to claim 12, Applicant changed component configuration to hardware system configuration.

Regarding claims 11 and 31, the Examiner indicated that the workload request output had no proper antecedent basis. In response, applicant has amended claims 11 and 31 to refer to the workload request output of the workload specification interface. Accordingly, Applicant believes that claims 11 and 31 are patentable.

Examiner Day indicated that claim 20 should be amended to correspond to the interfaces recited in the corresponding independent claim 11. In response, Applicant has amended claim 20 to comply with the Examiner's request.

Potential 35 U.S.C. § 101 Rejections

In the interview of Sept. 22, Examiner Day indicated that claim 21 may be rejectable under § 101 since a computer readable medium may include a modulated data signal, which may be unpatentable subject matter under § 101. Solely to further prosecution of the present application, Applicant has amended claim 21 to recite a computer readable storage medium. Accordingly, Applicant believes that claim 21 is valid under § 101.

In the interview of Sept. 22, Examiner Day indicated that claim 1 may be rejectable under § 101. In response to the Examiner's suggestion, and solely to further prosecution of the present application, Applicant has amended claim 1 to recite a computer implemented method. Accordingly, Applicant believes that claim 1 is valid under § 101.

In the interview of Sept. 27, Examiner Day indicated that claims 11 and 31 may be rejectable as being directed towards non-statutory subject matter. Specifically, the claimed infrastructure is considered to be "non-functional descriptive material". In the interview of Sept. 27, 2005, Applicant's attorney traversed the rejection under § 101 by noting that M.P.E.P. § 1206 IV.B.1 states that "functional descriptive material consists of data structures and computer programs which impart functionality when employed as a computer component. ... Nonfunctional descriptive material includes but is not limited to music, literary works and a compilation or mere arrangement of data." In accordance

with these definitions, Applicant's claimed infrastructure of claims 11 and 31 are not "non-functional descriptive material" as suggested by the potential rejection under § 101, since it is not music, a literary work, or a mere arrangement of data. Specifically, the claimed interfaces and database information interact with the claimed evaluation engine, and thus are not a mere arrangement of data. In this manner, the claimed infrastructure of claims 11 and 31 are not a mere arrangements of data, i.e., non-functional descriptive material.

Applicant's attorney also suggest that if the Examiner was suggesting that the claimed subject mater of claims 11and 31 are "functional descriptive material", the rejection is not appropriate under § 101. "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized." (M.P.E.P. § 1206 IV.B.1 citing *In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *In re Warmerdam*, 33 F.3d 1354 (Fed. Cir. 1994) (claim to data structure *per se* held non-statutory). Moreover, as stated in the M.P.E.P. § 1206 IV.B.1(a), "a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory." In a manner similar to *Lowry*, Applicant's claimed infrastructe of claims 11 and 31, as currently amended, are stored on a memory and executable by a processor a computing system, and thus are not non-functional descriptive material and not per se non-statutory. Accordingly, the systems of claims 11 and 31 are claimable subject matter under § 101 as described in M.P.E.P. § 1206 IV.B.1, *In re Lowry*, and *In re Warmerdam*. Thus, Applicant requested that the rejection under § 101 be withdrawn.

CONCLUSION

Accordingly, in view of the above amendment and remarks it is submitted that the claims are patentably distinct over the prior art and that all the rejections to the claims have been overcome. Reconsideration and reexamination of the above Application is requested. Based on the foregoing, Applicants respectfully requests that the pending claims be allowed, and that a timely Notice of Allowance be issued in this case. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee that is not covered by an enclosed check please charge any deficiency to Deposit Account No. 50-0463.

Respectfully submitted,

Microsoft Corporation

Date: 9/27/05 By: _____

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Sherry Smith

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